

REMARKS

Claims 44-89 are pending in the Application and all stand rejected in the Office action mailed January 21, 2010. No claims are substantively amended by this response¹. Claims 44, 63, and 71 are independent claims from which claims 45-62, 64-70, and 72-89 depend, respectively. Applicants respectfully request reconsideration of pending claims 44-89, in light of the remarks set forth below.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. §2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth "all reasons and bases" for rejecting the claims.

Applicants respectfully note that **no claims are substantively amended by this response, nor were claims amended in Applicants' prior two responses**. Therefore, no new issues are raised by this response that would necessitate a new search. Applicants respectfully submit that **the Application was filed more than six**

¹ Claims 60 and 87 have been amended to correct an antecedent issue as shown above.

years ago, has undergone extensive examination, and is in condition for allowance.

Rejections of Claims

Claims 60 and 87 were rejected under 35 U.S.C. §112, second paragraph. Claims 44, 48-50, 53-56, 61, 63, 64, 67, 68, 71, 75-77, 80-83, and 88 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel, *et al.* (US 4,723,238, hereinafter "Israel") in view of Suffern, *et al.* (US 5,724,413, hereinafter "Suffern"). Claims 45, 46, 51, 52, 65, 66, 72, 73, 78, and 79 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern and Row, *et al.* (US 5,163,13, hereinafter "Row"). Claims 47, 57-60, 69, 74, and 84-87 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern in view of Flanagan (US 4,100,377). Claims 62, 70, and 89 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern and Messenger (US 5,046,066). Applicants respectfully traverse the rejections, noting that all of the rejections over art are for reasons of alleged obviousness based upon the teachings of Israel and Suffern.

Applicants first note what is required to support a rejection under 35 U.S.C. §103. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." (emphasis added) M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78

USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

In addition, as noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." See MPEP §2143.03. Further, "[all words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." *Id.*

Thus, the law is clear that words of a claim cannot be merely disregarded during examination. Instead, all the words in a claim must be considered during the examination process.

Further, in *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). **It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious.** That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

Ex parte Hiyamazi, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988) (emphasis added).

I. Rejection Of Claims 60 And 87 Under 35 U.S.C. §112, 2nd Paragraph

Claims 60 and 87 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Applicants respectfully traverse the rejection. Notwithstanding, Applicants have amended claims 60 and 87 as shown above, respectfully submit that the amendments do not add new matter, change claim scope, nor give rise to any estoppel. Applicants respectfully submit that amended claims 60 and 87 are in compliance with 35 U.S.C. §112, second paragraph, and respectfully request that the rejection of claims 60 and 87 be reconsidered and withdrawn.

II. The Proposed Combination Of Israel And Suffern Does Not Render Claims 44, 48-50, 53-56, 61, 63, 64, 67, 68, 71, 75-77, 80-83, and 88 Unpatentable

Claims 44, 48-50, 53-56, 61, 63, 64, 67, 68, 71, 75-77, 80-83, and 88 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern. Applicants respectfully traverse the rejection.

With regard to independent claim 44, Applicants respectfully submit that claim 44 recites, in part, "[a] method for communicatively coupling a packet network to at least one communication network having an associated information format, the method comprising: ... receiving, from one of the packet network and the at least one communication network, information requesting setup of a call between the packet network and the at least one communication network; providing, to a host device, at least a portion of the information requesting setup of a call; receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call; and establishing call communication between the packet network and the at least one communication network based upon the configuration information, the communication including the conversion of information received in a packet format for transmission in the associated format, and the conversion of information received in the associated format for transmission in the packet format." Independent claim 71 recites similar features and was rejected using the same rationale over the same art. Applicants respectfully submit that the proposed combination of Israel and Suffern does not teach, suggest, or disclose all aspects of Applicants claim 44, and thus does not render claim 44 or any of the claims that depend from claim 44, unpatentable.

Initially, Applicants appreciate recognition by the Office, at page 3, that "Israel does not teach providing, to a host device, at least a portion of the information requesting setup of a call; receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call." The Office, however, then mistakenly relies upon Suffern, stating at page 3, "[h]owever, Suffern from a similar field of endeavor teaches an interface card that provides received signals to the host device for processing (**Suffern: figs. 1-4**)." (emphasis in original) Applicants respectfully disagree, and respectfully submit that claim 44 is allowable over the cited art for a number of reasons.

Initially, Applicants respectfully submit that **the Office cites Suffern at FIG.s 1-4, all of the drawings of Suffern, but fails to identify any specific elements within FIGs. 1-4, or any text from the 205 page disclosure of Suffern**, to help explain what in Suffern allegedly teaches the aspects of Applicants' claim 44 that are admittedly missing from Israel. The Office fails to provide any explanation or interpretation of FIGs. 1-4, or any other part of Suffern, to explain how and why Suffern teaches what is alleged. Instead, **the Office presents only a conclusory statement**, namely, that "Suffern from a similar field of endeavor teaches an interface card that provides received signals to the host device for processing." As Applicants noted above, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Further, the Federal Circuit has made clear that **"rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."** M.P.E.P. §2142 recognizes that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." The Office has not provided the required "clear articulation" to explain any reasons why the claimed invention would have been obvious. As Applicants also showed above, the Supreme Court has noted that the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit**. The Office has not provided an "explicit analysis" as required by the Court. Therefore, Applicants respectfully submit that the

Office has not met the requirements for a *prima facie* case of obviousness with respect to claim 44 or any of its dependent claims, for at least these reasons. Applicants respectfully submit that claim 44 is allowable over the cited art for additional reasons.

Applicants claim 44 recites in part, "providing, to a host device, at least a portion of the information requesting setup of a call," and "receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call." The Office action admits that Israel fails to teach at least these aspects of Applicants' claim 44. *See* Office action at page 3. The Office, however, asserts that Suffern teaches "an interface card that provides received signals to the host device for processing." (emphasis added) Applicants respectfully submit that even if Applicants agreed, *arguendo*, that Suffern teaches what is alleged, **which Applicants do not**, the Office **has failed to even address** the portion of Applicants' claim 44 that recites "receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call." M.P.E.P. §2143.03 recognizes that, '[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.' Applicants respectfully submit that the failure of the Office to even address at least this aspect of claim 44, admittedly missing from Israel, is sufficient to preclude establishment of a *prima facie* case of obviousness with respect to claim 44. Applicants respectfully submit that claim 44 is allowable for at least an additional reason.

Applicants respectfully submit that Applicants' claim 44 is drawn to "[a] method for communicatively coupling a packet network to at least one communication network having an associated information format," and that claim 44 recites, in part, "receiving, from one of the packet network and the at least one communication network, information requesting setup of a call between the packet network and the at least one communication network." Thus, Applicants claim 44 recites two networks, a "packet network" and "at least one communication network having an associated information format," and that the "received information" is "information requesting setup of a call" between (1) the packet network, and (2) the at least one communication network."

Applicants respectfully submit that, in contrast, Suffern "relates to electronic communications systems and more particularly to a system for enabling a computer to transmit and receive information over an analog communications link." (emphasis added) *Id.* at col. 1, lines 20-23. Applicants respectfully submit that a review of cited FIGs. 1-4 and related text of Suffern shows that Suffern teaches an "expansion/interface card 15" that plugs into an available socket 17 on the motherboard of a conventional IBM-compatible Personal Computer...." *Id.* at col. 2, lines 62-64. The "expansion/interface card 15" is provided with "a standard telephone jack 27 through which a connection is made to a conventional voice-grade analog communication link, also referred to as a telephone line ... which may be connect, in turn, to a remote device 18, such as a remote modem or a facsimile transmission device, with which the host computer communicates." *Id.* at col. 3, lines 21-28. Thus, "interface card 15" of Suffern teaches connection to a single network, namely, a "conventional voice-grade communication link" by a "host computer 20." Applicants respectfully submit that Suffern does not, however, teach, suggest, or disclose communicatively coupling first and second networks, in accordance with Applicants' claim 44. Applicants respectfully submit, therefore, that Suffern cannot teach, suggest, or disclose "providing, to a host device, at least a portion of the information requesting setup of a call [between (1) the packet network and (2) the at least one communication network]," as claimed. Further, Suffern cannot teach, suggest, or disclose "receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call [between (1) the packet network and (2) the at least one communication network]," as claimed. In other words, any information allegedly received by the "host computer" of Suffern is related to establishing a connection between "a remote modem or a facsimile transmission device" and the "host computer 20" **using a single network**, namely, a "conventional voice-grade analog communication link," which cannot teach, suggest, or disclose Applicants "information requesting setup of a call between the packet network and the at least one communication network."

Thus, for at least these reasons, Applicants respectfully submit that Suffern does not teach, suggest, or disclose, at least "providing, to a host device, at least a portion of the information requesting setup of a call," as recited by Applicants' claim 44.

Applicants further respectfully submit that Suffern also does not teach, suggest, or disclose "receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call," as recited by Applicants' claim 44. Therefore, Applicants respectfully submit that, contrary to the assertions of the Office, Suffern does not remedy the admitted shortcomings of Israel. Because the Office admits that Israel does not teach at least these features of Applicants' claim 44, and Applicants have shown that Suffern also does not teach at least these aspects, it necessarily follows that the proposed combination of Israel and Suffern cannot teach at least these aspects of Applicants' claim 44. Therefore, Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness with respect to claim 44, and that claim 44 and any claims that depend therefrom are allowable over the cited art.

With regard to independent claims 63 and 71, Applicants respectfully submit that claims 63 and 71 recite similar features and were rejected using the same rationale over the same art as claim 44. Applicants have shown that claim 44 is allowable over the cited art, and respectfully submit that claims 63 and 71 and their respective dependent claims are therefore allowable over the proposed combination of Israel and Suffern for at least the same reasons set forth above with respect to claim 44.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that the Office has not met the requirements for the establishment of a *prima facie* case of obviousness in view of Israel and Suffern with respect to claims 44, 63, and 71, or any of claims 48-50, 53-56, 61, 64, 67, 68, 75-77, 80-83, and 88 that depend therefrom. Accordingly, Applicants respectfully request that the rejection of claims 44, 48-50, 53-56, 61, 63, 64, 67, 68, 71, 75-77, 80-83, and 88 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

III. The Proposed Combination Of Israel, Suffern, and Row Does Not Render Claims 45, 46, 51, 52, 65, 66, 72, 73, 78, And 79 Unpatentable

Claims 45, 46, 51, 52, 65, 66, 72, 73, 78, and 79 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern and Row. Applicants respectfully submit that claims 45, 46, 51, and 52, claims 65 and 66, and claims 72, 73,

78, and 79 depend, respectively, from independent claims 44, 63, and 71. Applicants respectfully submit that claims 44, 63, and 71 are allowable over the proposed combination of references in that the Office has not shown that Row overcomes the admitted and demonstrated shortcomings of Israel and Suffern, discussed above. Because claims 44, 63, and 71 are allowable over the cited art, Applicants respectfully submit that claims 45, 46, 51, 52, 65, 66, 72, 73, 78, and 79 that depend from claims 44, 63, and 71 are also allowable over the proposed combination of Israel, Suffern, and Row for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 45, 46, 51, 52, 65, 66, 72, 73, 78, and 79 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

IV. The Proposed Combination Of Israel, Suffern, And Flanagan Does Not Render Claims 47, 57-60, 69, 74, And 84-87 Unpatentable

Claims 47, 57-60, 69, 74, and 84-87 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern in view of Flanagan. Applicants respectfully submit that claims 47 and 57-60, claim 69, and claims 74 and 84-87 depend, respectively, from independent claims 44, 63, and 71. Applicants respectfully submit that claims 44, 63, and 71 are allowable over the proposed combination of references in that the Office has not shown that Flanagan overcomes the admitted and demonstrated shortcomings of Israel and Suffern, set forth above. Because claims 44, 63, and 71 are allowable over the cited art, Applicants respectfully submit that claims 47, 57-60, 69, 74, and 84-87 that depend from claims 44, 63, and 71 are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 47, 57-60, 69, 74, and 84-87 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

V. The Proposed Combination Of Israel, Suffern, And Flanagan Does Not Render Claims 62, 70, And 89 Unpatentable

Claims 62, 70, and 89 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern and Messenger. Applicants respectfully submit that claims 62, 70, and 89 depend, respectively, from independent claims 44, 63,

and 71. Applicants respectfully submit that claims 44, 63, and 71 are allowable over the proposed combination of references in that the Office has not shown that Messenger overcomes the admitted and demonstrated shortcomings of Israel and Suffern, set forth above. Because claims 44, 63, and 71 are allowable over the cited art, Applicants respectfully submit that claims 62, 70, and 89 that depend from claims 44, 63, and 71 are also allowable over the proposed combination of Israel, Suffern, and Flanagan, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 62, 70, and 89 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Conclusion

In general, the Office Action makes various statements regarding the claims of the Application and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of the pending claims are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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